



01-16-03

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Kirk P. Seward et al	Docket No. :	IL-10625
Serial No. :	09/819,111	Art Unit :	1772
Filed :	March 27, 2001	Examiner	J. J. Rhee
For :	Shape Memory Alloy/Shape Memory Polymer Tools		

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REQUEST FOR RECONSIDERATION

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action mailed December 5, 2002, made final, kindly consider the following:

The 35 USC 112 Rejection

Claims 2, 8, 15, 16 and 28 are rejected under 35 USC 112, first paragraph, because certain terms of the claims are not set forth in Applicants' specification. Attention is directed to All Dental Prodx LLC v. Advantage Dental Products Inc., Fed. Cir., No. 02-1107, 10/25/02 held that "the specification need not describe the claimed subject matter in exactly the same terms as used in the claims". Thus, this rejection is clearly contrary to the above-cited decision by the U.S. Court of Appeals for the Federal Circuit. Thus, this rejection should be withdrawn.

The 35 USC 102 Rejection

Claims 2-6, 8-12, and 34-35 are rejected under 35 USC 102(b) as anticipated by Phan et al. Claim 2, for example, sets forth:

1. "a structure for at least positioning and bending a distal end of the device",
2. "said shape memory alloy having a longitudinally extending coiled configuration", and
3. "said shape memory polymer has a cylindrical configuration."

Phan et al teaches a device for insertion at a vascular site, which as shown in Figure 2B and 2C as having layers of material 32 and 34 in a helical configuration. Where is the "structure" recited in Claim 2 found in Phan et al? Where is the "cylindrical configuration" of the shape memory polymer found in this reference? Such clearly does not exist as both members 32 and 34 have a helical, not a "cylindrical" configuration. Thus, this ground of rejection should be withdrawn.

The 35 USC 103 Rejections

Claims 14 and 17-22 are rejected under 35 USC 103(a) unpatentable over Phan et al in view of Maynard. Each of these claims depends from Claim 2 and thus includes the limitations of the parent claim or claims. As pointed out above, Phan et al fails to teach the features of parent Claim 2, and Maynard fails to teach the features of Claim 2 lacking in Phan et al. Thus, since the references relied upon the Examiner fail to teach the features recited in the rejected claims, they fail to support a rejection of these claims under 35 USC 103. The rejection should be withdrawn.

Claims 32 and 33 are rejected under 35 USC 103(a) as unpatentable over Phan et al in view of Lee et al. These claims depend from Claim 2. As pointed out above, Phan et al fails to teach the features of parent Claim 2, and Lee et al fails to teach the features lacking in Phan et al. Thus, this ground of rejection is improper and should be withdrawn.

Conclusion

In view of the foregoing, it has been shown that the features of the claims have not been taught or suggested by the applied references. Thus, the rejections are improper and should be withdrawn. Accordingly, this application should be allowed.

Respectfully submitted,

Dated: 1-14-03



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